

The opinion in support of the decision being entered today was  
not written for publication and is not binding precedent of the Board

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JEAN-MARC ANDREOLI  
AND  
UWE M. BORGHOFF

Appeal No. 2005-0344  
Application 09/421,846

MAILED

MAY 31 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ON BRIEF

Before THOMAS, HAIRSTON, and LEVY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final  
rejection of claims 1-16.

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Representative independent claim 1 is reproduced below:

1. A method for obtaining document constraint descriptors based on user signals, the method comprising:

(A) receiving user signals indicating a set of attribute-value relations that can apply to documents;

(B) using the user signals to obtain, without requiring user intervention, logical relations equivalent to the attribute value relations, the logical relations comprising at least one of a sort and a feature; and

(C) using the logical relations to obtain, without requiring user intervention, a document constraint descriptor defining a set of one or more constraints equivalent to the logical relations.

The following references are relied on by the examiner:

|                        |           |                                              |
|------------------------|-----------|----------------------------------------------|
| Karnik                 | 5,404,294 | Apr. 4, 1995                                 |
| Rubenstein ('897)      | 5,721,897 | Feb. 24, 1998<br>(filing date July 26, 1996) |
| Rubenstein ('233)      | 5,794,233 | Aug. 11, 1998<br>(filing date April 9, 1996) |
| Wilson et al. (Wilson) | 5,963,938 | Oct. 5, 1999<br>(filing date May 17, 1996)   |

Claims 1-16 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Rubenstein '233 in view of Wilson as to claims 1-5, 8 and 13-16, with the addition of Karnik as to claims 6

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and 7. Dependent claims 9-12 stand rejected on the basis of Rubenstein ('233) in view of Wilson, further in view of Rubenstein ('897).

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for the appellants' positions, and to the answer for the examiner's positions.

#### OPINION

We reverse. Since apparatus independent claim 13 has corresponding limitations to method independent claim 1, we treat independent claim 1 as representative for purposes of our analyses.

As revealed in the Background of the Invention and the Andreoli Journal article discussed there, the disclosed and claimed invention relates to constraint-based knowledge brokers. As revealed at specification page 4, a typical user has difficulty formulating so-called "sorts and features" to produce a desired constraint since prior art techniques are only useful by expert users who understand these terms of art. In fact, the terms "sort" and "feature" are discussed and otherwise defined at prior art specification page 4, in the discussion at pages 19 and 20 as well as the additional

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discussion at specification pages 24 and 25. Additionally, specification pages 8-13 set forth the definitions of particular terms of art as they apply to the disclosed and claimed invention. It appears to us that the examiner has not made use of this background of the invention and definitional information to the extent necessary to convince us of the obviousness of the subject matter of representative independent claim 1 on appeal.

To simplify claim 1 for our purposes here, a user enters a query which yields attribute value relations, which are automatically converted to logical relations which are equivalent to the attribute value relations, where the logical relations comprise "at least one of a sort and a feature," such that these logical relations are automatically converted to document constraint descriptors at the end of claim 1 as set forth as a desired result in the preamble of this claim.

In light of appellants' arguments in the brief and reply brief, our understanding of Rubenstein ('233) and Wilson in the first rejection under 35 U.S.C. § 103, the examiner's positions and our understanding of the claimed invention in representative independent claim 1 on appeal, we

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must reverse the rejection of these claims. Even if we agree with the examiner's position that Rubenstein ('233) and Wilson are properly combinable within 35 U.S.C. § 103, there is no inputting by a user of attribute-value relations which are in turn equivalent to and converted to logical relations, which are in turn again converted to and equivalent to document constraint descriptors as these terms of art are recited in representative claim 1 on appeal. Neither Rubenstein ('233) nor Wilson directly address the field of art relating to constrain-based knowledge brokers but only appear to relate to related fields of invention. That Rubenstein ('233) utilizes linguistic analysis and Boolean operators and Wilson in turn uses logical and Boolean operators to formulate text-organized searched arguments, the artisan would well appreciate the subject matter of representative independent claim 1 on appeal would not have resulted from the combined teachings and suggestions of both references.

As noted earlier, "a sort" and "a feature" are terms of art of constrain based knowledge brokers which has apparently gone unappreciated by the

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examiner. The mere fact that the bottom of column 3 at lines 45-55 teaches the concept of sorting as one of the types of logical functions utilized in Wilson's system does not necessarily make it equivalent to the claimed "a sort." These two terms, sort and feature, are terms of art which we have indicated earlier clearly are defined in the specification. In fact, all of the definitional terms set forth in the specification establish a context into which the claims on appeal must be properly interpreted by an artisan. Some of these terms of art in representative claim 1 on appeal have been argued by appellants in the brief and reply brief in a definitional sense as disclosed. The examiner's arguments in the Responsive Arguments portion in the answer have not come to grips with these positions.

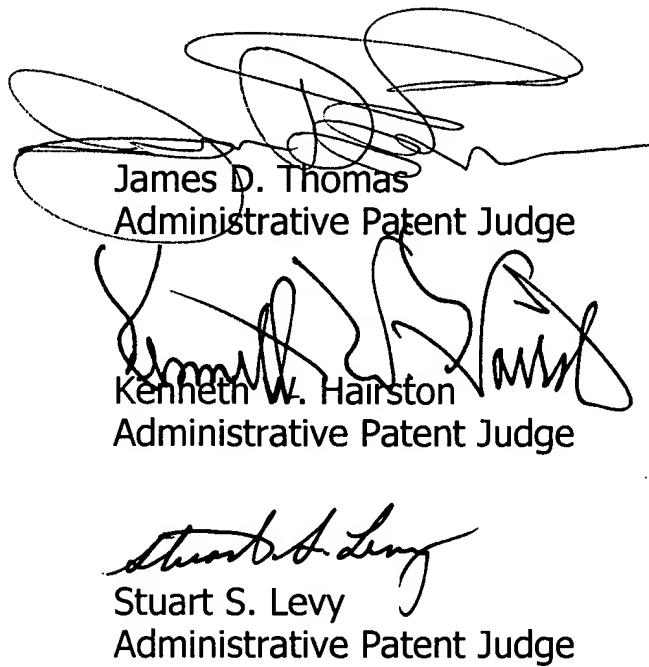
Since we do not sustain the rejection of independent claims 1 and 13 on appeal, we reverse the separate rejections of their respective dependent claims since the additional applied prior art does not cure these deficiencies.

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Therefore, the decision of the examiner rejecting claims 1-16  
under 35 U.S.C. § 103 is reversed.

REVERSED

James D. Thomas )  
Administrative Patent Judge )  
Kenneth W. Hairston )  
Administrative Patent Judge )  
Stuart S. Levy )  
Administrative Patent Judge )  
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